

REMARKS

Reconsideration of the outstanding Office Action is respectfully solicited.

Claim 10 has been amended to recite information found in the specification at page 6 second paragraph. Claim 11 is cancelled. New claim 13 is directed to specific surface active substance(s), recited as lipids, aerosol-OT, phospholipids and glycolipids; these are disclosed on page 6, 3rd paragraph of the present specification.

Applicants note the U.S. PTO Examiner's request under Rule 105. This requirement is discussed at the end of this paper; a concurrently filed IDS cites the J. Krauthkrämer reference cited at page 1 of the specification.

Applicants respectfully traverse the rejection of claims as anticipated or as obvious, in view of the grounds of rejection based on US 5,633,213 (Aghajanian et al or Wong et al. (US 4,691,714) "or applicants' admission" in the outstanding Office Action. Initially it is noted that "an admission" cannot be used as evidence for anticipation, as Section 102 itself defines the evidence which can be used to establish 'lack of novelty' and 'an admission' is not recited in Section 102. If information does constitute 'an admission' it is explainable, just as a prima facie case is rebuttable. Applicants request reconsideration in view of the originally filed claims and the Claims presented herein. Claim 10 recites, inter alia

"wherein said mixture comprises 10 to 30 weight % water, 10 to 30 weight % of surface active substance and 40 to 80 weight % of polysaccharide or disaccharide."

The Examiner refers to US 5,633,213 (Aghajanian et al.) which used the word honey and suggests that honey may be used as a coupling medium for transversal ultrasonic waves. Wong et al. (U.S. 4,691,714) only discloses honey --at column 47-- as a test substance for checking the function of the apparatus cited in this document. Honey is described on page 2 of the present specification. Moreover, at page 2 of the application it is also stated, that,

"However, honey as well as glue can not be reproducibly produced,[specification page 2 lines 18-19"

Applicants rely on Section 2131 of the Manual of Patent Examining Procedure which teaches the disclosure requirements of a printed publication applied to negate novelty. That section of the MPEP indicates that there must be a one-to-one correspondence between the reference description and that of the claims under scrutiny.

Using the MPEP Section 2131 as a guideline, it is clear that neither US 5,633,213 (Aghajanian et al) nor Wong et al. (Us 4,691,714) nor allegedly "or applicants' admission" describes

"wherein said mixture comprises 10 to 30 weight % water, 10 to 30 weight % of surface active substance and 40 to 80 weight % of polysaccharide or disaccharide."

Since none of the information relied upon by the U.S. PTO provides written description of the homogenized mixture comprising three components, previously and now presently, recited in the claims at issue, the references do not provide a *prima facie* case of lack of novelty. Accordingly, withdrawal of the rejections for lack of novelty is respectfully solicited.

Applicants respectfully traverse the rejections for obviousness.

The USPTO has presented no rationale to combine the references (b) to arrive at the present invention. The Court has stated,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach

or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The U.S. PTO furthermore refers to literature indicating that natural honey may also contain traces of organic acids (less than 1 % specifically, 0.57 %); see Encyclopedia of Food Technology, page 104). This clearly does not satisfy any criteria of the claims at issue. That is, literal combination of the Encyclopedia of Food Technology with the references would result in a combination of honey and 0.57 of an organic acid. That combination is not applicants' claims.

Moreover, the U.S. PTO relies upon Hawley's entry of the word "butyric acid." Apparently, the U.S PTO also relies upon its designated uses:

“Hazard: Strong Irritant to skin and tissue.

Uses: Synthesis of butyrate ester perfume and floavor ingredients, pharmaceuticals, deliming agent, disinfectants, emulsifying agents, sweetening gasolines” [Hawley, “butyric acid”]

Hawley is irrelevant to Claim 10 which does not refer to butyric acid, is far from relevant to claim 12 which refers to biocompatible substances [please see Hawley's designation of Hazard] and irrelevant to the terms of claim 13.

In summary, it is applicants' view that the combination of these references, literal or otherwise, does not result in applicants' claims; and the differences between applicants' claims and combination requires hindsight to arrive at applicants' claims. With respect to a determination under Graham, applicants submit the following additional comments.

Since honey is a natural product, the content of honey may vary depending on the origin and further processing. Honey may also include traces of other substances, like rests of car tires, pizzas, metals or animal cadavers.

Nevertheless, such additional substances are only included in a very low concentration. In the present invention the homogenous mixture used for the coupling of transversal ultrasonic waves, however, contains from 10 to 30 weight % of the surfactant since this surfactant is a very important component of the present coupling medium. The present homogenous mixture with the claimed content can be easily (synthetically) produced in a reproducible manner and therefore always provides the same coupling properties. This is not achievable with natural honey as already stated above.

The content of the claimed coupling medium having between 10 and 30 weight % of the surfactant can not be obvious from the disclosed contents of honey which only contains less than one percent of organic acids, of which one may also be used in pharmaceutical, as deliming agent, as disinfectant or as sweetening gasoline. The skilled person using honey as a coupling medium does not have any idea of the function of such organic acids in honey and clearly does not get any hint to provide a homogenized mixture of 10 to 30 % of a surfactant, at least one polysaccharide or one disaccharide and water as a coupling medium for transverse ultrasonic waves.

The subject matter of the present set of claims, therefore, is clearly neither anticipated nor obvious in view of the cited prior art. Accordingly, applicants also respectfully request withdrawal of the rejections under 35 U.S.C. 103.

Applicants hereby respond to the requirement under Rule 105 and note a concurrently filed IDS. In response to the Examiner's requirement applicants have responded by commenting on pages 1- 2 of the specification, as follows:

With respect to the requirement under 37CFR § 1.105 please find enclosed a copy of pages 296 to 299 of the book of J. Krautkrämer cited at the bottom of

page 1 of the present specification. Paragraph 15.3 of this book refers generally to coupling media. The part marked on page 297 especially relates to the coupling of transversal ultrasonic waves and the media used for this task, which are already mentioned in the paragraph bridging from page 1 to page 2 of the present specification.

For the use of the further coupling medium mentioned on page 2 of the present specification, i.e. honey, the applicant does not know of any written document dealing with the use of honey as a coupling medium for transversal ultrasonic waves.

The description [...] on this page is based on the practical experience and common knowledge in the field of transversal ultrasonic waves.

The problem arising with the use of honey as a coupling media, however, is the lack of reproducibility of the coupling behavior. This is due to the fact that honey is a natural product which therefore cannot be provided with a reproducible quality.

Applicants respectfully request withdrawal of the rejections under 35 U.S.C. 103.

Reconsideration and an early allowance are respectfully solicited.

Respectfully submitted,

Date:

07/18/2004



Marina V. Schneller
Registration No. 26,032
VENABLE LLP
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 344-4062
Telefax: (202) 344-8300